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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT PAPER NUMBER

3623

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/245,798

Applicant(s)

O'DONNELL ET AL.

Examiner

Akiba K Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47, 49-64, 72-74, 76-80 and 84-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47, 49-64, 72-74, 76-80, 84-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. In response to the communication filed 7/28/03, the following is a final office action. Claims 1-46, 48, 65-71, 75, and 81-83 are cancelled in this application. Claims 47, 49-64, 72-74, 76-80 and 84-93 are pending and have been examined on the merits, and have been rejected. Any amendments to the claims have been addressed in the rejection. The previous rejection has been withdrawn and the following rejection reflects the claims as amended.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 47, 72-74, 76-79, 84-93 are rejected under 35 U.S.C. 102(b) as being anticipated by Erickson (US 5,765,152).

As per claim 47, Erickson discloses:

Having on a computer network a license offering server that presents web pages...(Col. 5, lines 10-13, lines 37-39, Col. 9, lines 42-45, Col. 3, lines 20-25, Abstract, lines 8-11);

Each web page associate with one of a plurality of viewable works of authorship...(Col. 12, lines 64-66, Fig. 4 [60], where the Document is viewable and includes more than one work, Col. 5, lines 36-38, Col. 12, lines 62-66);

And with a unique work identifier...(Col. 11, line 65-Col. 12, line 4, [Document ID]);

Each web page presenting to ay of a plurality of client computers on the network an offer of a license to use the associated viewable work of authorship...(Col. 27, lines 3-6, where the presentation of the auxiliary permissions in Erickson serves as the offer of the license);

From a server on the computer network, providing to a client computer on the network one of said works of authorship...(Col.27, lines 6-12);

and causing the client computer to display, as a viewable part of said viewable work, a hotspot, which when selected at the client computer, provides the unique work identifier associated with said work for use as part of a network address, thereby directing the client computer to the licensing web page for the associated work of authorship...(Col. 17, lines 14-18, where the user double-clicks on the document ID in the scroll view and can initiate a transaction with the registration server by selecting a document ID from this list, in this case the presentation of the document ID is a representation of a hotspot w/ Col. 11, lines 37-54, Fig. 7, (Licenseit! button) also represents a hotspot since the VIEWER presents this option to the user so when this icon is clicked it takes the user to the licensing web page for the associated work.

These hotspots are viewable parts of the viewable work since all pages presented by

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the viewer are linked to one another. In this case, the viewer presents both the Licenseit! button and the actual document or viewable work).

Receiving at the license offering server a request from the client computer to present the licensing web page for the associated work of authorship...(Col. 3, lines 38-41).

As per claims 49, 86, Erickson discloses:

Wherein the work of authorship is a text article...(Col. 4, lines 56-58);

having a beginning and an end and the hotspot is located at the end...(Fig. 7, Licenseit! icon [hotspot] is at the end [bottom] of page).

As per claims 50, 87, Erickson discloses the following:

Wherein the unique work identifier is a universal resource name within the network...(Col. 11, lines 42-47).

As per claims 51, 88, Erickson discloses:

wherein the unique work identifier includes an identifier of the publisher of the work...(Col. 4, lines 1-4, where the publisher is a user of the system shown by Col. 21, lines 50-53).

As per claims 52, 63, 89, Erickson discloses:

Wherein each licensing web page/ Wherein the record includes one or more of: a title of the associated work, a name of an author of the associated work, and a name of a publisher of the associated work...(Col. 5, lines 61-64).

As per claims 53, 90, Erickson discloses:

Wherein each licensing web page includes a field in which a type of permission can be selected...(Col. 3, lines 31-33).

As per claims 54, 91, Erickson discloses:

and the associated licensing web page includes a field in which a portion of the article to be used can be specified...(Col. 3, lines 30-40, [permissions]).

Wherein the work of authorship is a text article...(Col. 4, lines 56-58),.

As per claims 55, 92, Erickson discloses:

Indicating that offered license terms have been accepted...(Col. 27, line 64-Col. 28, line 1);

Wherein each licensing web page includes a hot spot ...(Col. 17, lines 14-18, where the user double-clicks on the document ID in the scroll view and can initiate a transaction with the registration server by selecting a document ID from this list, in this case the presentation of the document ID is the hotspot w/ Col. 11, lines 37-54).

As per claims 56, 93, Erickson discloses:

Wherein the computer network comprises the global computer network...(Col. 9, lines 37-40).

As per claims 57, 77, Erickson discloses:

Having on a computer network a server that presents web pages...(Abstract, lines 8-11, Col. 5, lines 10-13 and lines 37-39, Col. 9, lines 42-45);

each web page associated with one of a plurality of source works of authorship.../a database component that generates web pages, each web page being associated with at least one of a plurality of source works of authorship...(Fig. 4 [60]

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where the document includes more than one work, Col. 5, lines 36-38, Col. 9, lines 42-45, Col. 12, lines 62-66/Col. 23, lines 4-8);

each web page presenting to any one of a plurality of client computers an offer of a license to use the associated source work of authorship...(Col. 24, lines 52-55, where the Server presenting terms for licensing indicates an offer of the license);

Receiving at the server from one of said client computers, relating to one of said web pages, an acceptance of the license to use the associated source work of authorship.../a receiving component that receives acceptances from users, each acceptance relating to one of the web pages...(Col. 27, line 64-Col. 28, line 1);

In response to receiving the acceptance creating on a server on the computer network a record associated with said accepted license and containing information about said accepted license, said record identified by a unique license identifier and accessible by said client computer.../a licensing record component that receives each acceptance, and, in response to receiving the acceptance, generates a record associated with the accepted license and containing information about the terms of the accepted license...(Col. 11, line 65-Col. 12, line 4, Col. 11, Col. 8, lines 26-33, where the packager is complimentary to the viewer).

Providing to said client computer said unique license identifier...(Col. 24, lines 27-35 w/ Col. 20, lines 51-55).

As per claim 58, Erickson discloses:

Wherein the license identifier comprises a number...(Col. 11, lines 37-40).

As per claim 59, Erickson discloses:

Wherein the record on the server is accessible by a client computer in the form of a web page presenting terms for the accepted license...(Col. 5, lines 36-38, Col. 8, lines 26-30 w/ Col. 9, lines 42-45).

As per claim 60, Erickson discloses:

Further comprising the step of the server receiving from a client computer said unique license identifier and using said unique license identifier to find the record...(Col. 17, lines 14-18, lines 38-42, w/ Col. 11, lines 45-53).

As per claim 61, Erickson discloses:

Wherein the server solicits from the client computer a name of the licensee and records the name in the record...(Col. 3, line 64-Col. 4, line -4).

As per claim 64, Erickson discloses:

Wherein the computer network comprises the global computer network...(Col. 9, lines 37-40).

As per claim 72, Erickson discloses:

A registration component the receives registration information for a set of works of authorship from a first client system...(Col. 14, line 61-Col. 15, line 7);

The registration component also generating a first code corresponding to the licensing terms record and thereafter providing the first code to the first client system, the first code including information enabling a second client system to access the license record...(Col. 11, line 43-48);



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A clearance component that receives from the second client system a request to access the licensing terms record in the registration component...(Col. 6, line 62-Col. 7, line 2, w/ Col. 5, lines 26-29);

The request including user information and acceptance of terms of a license corresponding to the licensing terms record...(Col. 7, lines 7-11, Col. 5, lines 26-29 w/ Col. 21, lines 42-48);

And the clearance component providing to the second client system a second code corresponding to a license granted for the work of authorship associated with the licensing terms record...(Col. 19, lines 20-31, [each usage right]);

And generating a corresponding license record for the granted license accessible from a client computer as a web page corresponding to the second code...(Col. 11, line 65-Col. 12, line 6);

And generates a licensing terms record in a database corresponding to the set...(Col. 8, lines 36-42, Col. 20, lines 62-67);

As per claim 73, Erickson discloses:

Wherein the request received by the clearance component from the second client system comprises a request from a web browser running on the second client system, the web browser generating the request from the first code...(Col. 17, lines 24-44, [launch a licensing transaction after clearance occurs]):

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for a request from a web browser to come from the clearance

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component with the motivation of utilizing traditional resources on the web to access information, w/ Col. 3, lines 26-33 and lines 45-63, shows subsequent on-line licensing);

As per claim 74, Erickson discloses:

Wherein the clearance component further provides along with the second code a copy of the work of authorship to the second client system ...(Col. 12, lines 26-41 w/ Col. 5, lines 25-29).

As per claim 76, Erickson discloses:

Wherein the registration and clearance components communicate with client systems over the global computer network...(Col. 9, lines 42-45).

As per claim 78, Erickson discloses:

Wherein each of the plurality of users corresponds to a client system...(Col 4, lines 44-46).

As per claim 79, Erickson discloses:

Wherein each unique license identifier comprises one of or both of: a visual representation conveying information enabling a user to access the record associated with the license and a machine-readable portion enabling the user to access the record through a web browser... (Fig. 7, [licenseit! button], Col. 5, lines 36-44, lines 50-55, [visual representation]).

As per claim 85, Erickson discloses:

Wherein the hot spot includes an icon representing an action to obtain a license relating to the work of authorship, (Fig. 7, [licenseit! button}, this button represents the icon since it links the user to the page where he can actually obtain the license]).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 80 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson.

As per claims 80, Erickson fails to disclose the following:

Wherein each record comprises a markup language file that may be displayed by a user through a web browser...

Official notice is taken that it is old and well known in Internet related art for a record to comprise a markup language file that may be displayed by a user through a web browser. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the record to comprise a markup language file that may be displayed by a user through a web browser with the motivation of having means to direct a specific user to a particular web page. In addition, Erickson teaches that the invention utilizes an Internet Domain Name Service to find a network or TCP/IP address. In Internet technology, html is a standardized language used for this type of file transmission.

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6. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (US 5,765,152) and further in view of Kahn et al (US 6,135,646).

As per claim 62, Erickson discloses:

Wherein the server solicits from the client computer an address and sends to the client computer a message...(Col. 4, lines 1-4);

Erickson fails to disclose, however Kahn et al discloses:

that printed copies of the work of authorship will be delivered to the specified address...(Col. 28, lines 14-20.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to send a message stating the printed copies of the work of authorship will be delivered to a certain address with the motivation of visually producing the document signals at a specific location so the user can easily locate and access the document.

### ***Response to Arguments***

7. Applicant's arguments filed 7/28/03 have been fully considered but they are not persuasive.

As per claim 47, the applicant argues that Erickson does not disclose or suggest the use of an icon within the hotspot. However the Licenseit! button does represent an icon due to the fact that it is a symbol used to link the user to the page where the licensing procedure can be triggered. In this case, the word Licenseit! is the icon since it is not really a word, but a symbol used to link the user to the licensing page.

As per claim 57, the applicant argues that Erickson does not provide to any client computer a unique license identifier to identify a record with information about a granted license. The applicant mentions Col. 19, lines 54-56 where Erickson talks about use-base information and how it is only available to the administrators. However, this use-base information describes a way to access charges to the owners of the servers for services rendered in connection with the servers. However, if one looks at Col. 11, line 65-Col. 12, line 11, Erickson talks about Source Work Extensions. These Source Work Extensions allow the licensee to view the Document ID and the permissions mask in the derivative work. These Source Work Extensions are included in the document.

Claims 58-64 depend from claim 57 and are therefore rejected for the same reasons as discussed with respect to claims 58-64.

As per claims 72-76, the applicant argues these claims for the same reasons as claims 57-64. Claims 72-76 are therefore rejected for the same reasons as discussed with respect to claims 72-76.

As per claim 72, the applicant also argues that Erickson does not disclose that the clearance component provides the 2<sup>nd</sup> client system a 2<sup>nd</sup> code. However, this is inherent with the Source Work Extensions discussed in col. 11, line 65-Col. 12, line 15, Here, Erickson discloses that the data fields within the Sources Works Extensions can include any of the Source Works Extension Code, meaning that there is more than one code associated with a particular work.

Claims 73, 74, and 76 all depend from claim 72 and are rejected for the same reasons as disclosed above with respect to claim 72.

Claim 77 is rejected for the same reasons as disclosed above with respect to claims 57 and 72.

Claims 78 and 80 are rejected for the same reasons as disclosed above with respect to claim 77.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.  
October 6, 2003



TARIQ R. HAFIZ  
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